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REMARKS

Claim rejections under 35 USC 103

　　　　Claims 1-4, 6-7, 9-11, 14, 16-18, and 22 have been rejected under 35 USC 103(a) as being unpatentable over Schoenzeit (5,619,624) in view of Neuhard (6,052,198). Claims 8, 12, 13, 15, and 21 have been rejected under 35 USC 103(a) as being unpatentable over Schoenzeit in view of Neuhard, and further in view of Berry (6,707,563). Claims 5 and 19-20 have been rejected under 35 USC 103(a) as being unpatentable over Schoenzeit in view of Neuhard, and further in view of Eisele (2002/0109869). Claims 1, 10, and 17 are independent claims, from which the remaining claims rejected on this basis ultimately depend. Applicant respectfully submits that claim 1 as originally presented, and claims 10 and 17 at least as previously presented, are patentable over Schoenzeit in view of Neuhard, such that the remaining claims rejected on this basis are patentable at least because they depend from patentable base independent claims.

　　　　Insofar as the rejection over Schoenzeit in view of Neuhard is concerned, Applicant discusses claim 1 as representative of all the independent claims, because the other independent claims 10 and 17 at least substantially recite the limitation of claim 1 that Applicant submits is not found in Schoenzeit in view of Neuhard. In particular, claim 1 is limited to "requesting the RIP engine to perform dynamic configuration of at least one RIPing parameter when the RIPing parameter is not congruent to a RIP manager supplied processor preference." Applicant respectfully submits that this limitation is not found in Schoenzeit in view of Neuhard.

　　　　In the previous office action response, Applicant explained how the claimed invention is limited to performing dynamic configuration of at least one RIPing parameter, whereas Schoenzeit in view of Neuhard suggests generating a RIPed version of a print job. In the final office action, the Examiner has in effect argued that generating a RIPed version of a print job reads on the limitation of performing dynamic configuration of at least one RIPing parameter. Therefore, the primary points of disagreement between the Examiner and Applicant are:

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(1) whether a *print job*, such as a RIPed version of a print job, can be considered a *parameter*; and, (2) whether *generating* a RIPed version of a print job can be considered *configuring*.

As to the first point of disagreement, Applicant respectfully submits that a print job or a RIPed version of a print job is not a parameter. As noted in the previous office action response, a *parameter* is relevantly defined as a *characteristic or factor, aspect, or element*. A RIPed version of a print job, or a print job, is not a characteristic, factor, aspect, or element, however. The Examiner has not disagreed with Applicant in this respect, but rather has argued that the definition of parameter implicitly suggested by reference number 120 of FIG. 1 of the patent application as filed encompasses a print job.

Reference number 120 of FIG. 1 of the patent application as filed provides examples of RIPing parameters by stating "E.g., print job and/or default values, download address, etc." It is important to consider the commas placed in this statement. By saying "print job and/or default values, download address, etc.," the term "print job" is not considered as a parameter itself, but rather is used an adjective modifying the term "values," meaning that the values in question that can be parameters are "print job and/or default values" – i.e., print job values and/or default values. Thus, reference number 120 of FIG. 1 of the patent application does not suggest that a print job itself can be a parameter – which indeed, makes no sense in consideration of the definition of parameter noted in the previous paragraph.

Applicant respectfully submits that the Examiner is construing the statement associated with reference number 120 of FIG. 1 of the patent application as filed as meaning "E.g., print job[,] and/or default values, download addresses, etc." That is, the Examiner is implicitly inserting a command between "print job" and "and/or default values" in order to interpret the term parameter as meaning a print job. However, there is no comma between "print job" and "and/or default values" in the statement associated with reference number 120 of FIG. 1 of the patent application. As such, the Examiner's interpretation is incorrect – the phrase "print job and/or

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default values, download addresses, etc." means that parameters include one or both of two types of values – print job values and default values – as well as download addresses.

In this respect, Applicant respectfully refers the Examiner to the Internet web page http://en.wikipedia.org/wiki/Serial_comma that discusses this type of issue with commas. This web page notes the following example: "My favorite types of sandwiches are pastrami, ham, cream cheese and peanut butter and jelly." If there is no comma between "cream cheese and "and peanut butter and jelly," then there are three types of sandwiches: (1) pastrami; (2) ham; and, (3) cream cheese and peanut butter and jelly." This is equivalent to the example parameters associated with reference number 120 of FIG. 1 of the patent application as filed, which states "print job and/or default values, download address, etc.," and thus which means that there are three example types of parameters: (1) print job and/or default values (meaning print job values and/or default values, as discussed above); (2) download address; and, (3) "etc."

By comparison, if there is a comma between "cream cheese" and "and peanut butter and jelly," then there are four types of sandwiches in the sentence "My favorite types of sandwiches are pastrami, ham, cream cheese, and peanut butter and jelly": (1) pastrami; (2) ham; (3) cream cheese; and, (4) peanut butter and jelly. This is what the Examiner is doing, inserting a comma between "print job" and "and/or default values." Thus, if the example parameters associated with reference number 120 of FIG. 1 of the patent application as filed had stated "print job, and/or default values, download address, etc.," then the Examiner would be correct, in that the example parameters expressed in the patent application would be: (1) print job; (2) default values; (3) download address; and, (4) "etc." However, this is not what the patent application says: the patent application says that two example parameters are (1) *print job values* and/or (2) *default values*, not that the two example parameters are (1) *print job* and/or (2) default values.

The absence of a comma between "print job" and "and/or default values" is thus important to consider in correctly interpreting the phrase "print job and/or default values" in the list "print job and/or default values, download address, etc." As discussed above, if you list sandwiches as

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"cream cheese and peanut butter and jelly, pastrami, etc." then this means that there are three types of sandwiches: (1) cream cheese and peanut butter and jelly; (2) pastrami; and, (3) "etc." – and not four types: (1) cream cheese; (2) peanut butter and jelly; (3) pastrami; and, (4) "etc." – because there is no comma between "cream cheese" and "and peanut butter and jelly." Likewise, listing example parameters as "print job and/or default values, download address, etc." means that there are three types of example parameters: (1) values, which may be print job values and/or default values; (2) download address; and, (3) "etc." –and not four types (1) print job; (2) default values; (3) download address; and, (4) "etc." – again, because there is no comma between "print job" and "and/or default values."

Applicant presents the foregoing discussion to explain why the Examiner has interpreted the patent application incorrectly as to what a parameter is. Of course, however, the words and phrases presented in the patent application are not to be interpreted in a vacuum. The ordinary meaning of a term also has to be considered. (See, e.g., Toro Co. v. White Consol. Indus., Inc., 199 F.3d 1295, 1299, 53 USPQ2d 1065, 1067 (Fed. Cir. 1999).) Besides the Examiner's tortured interpretation of the patent application to encompass the phrase "print job" as a type of "parameter" – which is incorrect as noted above – Applicant notes that the Examiner has not provided any other example in which a "print job" can be considered a "parameter." This makes sense, because a print job is not a parameter.

Indeed, consider this general definition of a parameter a used in computing like the claimed invention, as provided at the Internet web site en.wikipedia.org/wiki/Parameter_(computer_science): "In computer programming, a parameter is a variable that takes on the meaning of a corresponding argument passed in a call to a subroutine." A print job value (i.e., a value specified by a given print job), a default value (i.e., a value that is the default value if a print job has not specified a value), and a download address, as noted in accordance with reference number 120 of FIG. 1 of the patent application as filed, are

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thus types of parameters. Consider the more thorough list of parameters described in the patent application as filed:

> Such parameters include, for example, the ability to RIP a particular PDL type (i.e., the PDL used to express portions of the print job 112), use of a particular RIPing algorithm (e.g., a specific halftoning technique, software version, etc.), a set of desired font characteristics required by the print job, press designations (generically as a press family type or as a specific individual press), ICC profiles (color management), and so on.

(P. 6, para. [0019].) Thus a parameter is a variable that takes on a meaning. The ability to RIP a particular PDL type is a parameter that can be set, for instance, to "yes" or "no." Likewise, use of a particular RIPing algorithm is parameter that can be set, for instance, "algorithm one," "algorithm two," etc.

Note, however, how inconsistent and indeed incorrect it is to say that a *version of a print job that is to be generated* is a "parameter." You can generate a version of a print job in accordance with one or more parameters – like those described in the patent application as filed as noted above – but the version of the print job that is itself generated is not a parameter. A print job is not "a variable that takes on the meaning of a corresponding argument passed in a call to a subroutine," for instance. A print job is not a characteristic/factor/etc. In sum, then, to say that the prior art's print job, or a version of the print job, corresponds to a parameter in the claimed invention is incorrect; the only way the Examiner has been able to correspond the former with the latter is by misinterpreting the patent application as filed by introducing a comma into the text associated with reference number 120 of FIG. 1 where no comma exists.

As to the second point of disagreement, as to whether *generating* a version of a print job can be considered *configuring* a parameter as in the claimed invention, Applicant notes that the term "configuration" means the way in which something is set up, as discussed on page 9 of the previous office action response. By comparison, the online dictionary www.dictionary.com relevantly defines generation as meaning "the act or process of being generated," where the term generate itself relevantly means to "create," "to bring into existence," or "to cause to be."

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From these definitions, it is abundantly clear that *generating* something is not the same as *configuring* something.

For example, say I *configure*, or set up, a widget. This means that I set up the widget, which presumes that the widget already exists – because if the widget did not already exist, then there is no way I could set it up. By comparison, say I *generate*, or bring into existence, a widget. This means that I bring the widget into existence, which presumes that the widget did not already exist – because if the widget did already exist, then it would be pointless to say that I am bring it into existence. Thus, you can first *generate* a widget, *and then configure* the widget – but the *generation* process is different than the *configuration* process. That is, generating a version of a print job, as in the prior art in combination, does not suggest configuring a parameter, as in the claimed invention. The act of generating is not the same as, and does not suggest, the act of configuring.

More specifically, as noted on page 9 of the previous office action response, the prior art in combination suggests generating a RIPed version of a print job, whereas the claimed invention is limited to performing configuration of at least one RIPing parameter. As noted above, a print job is not a RIPing parameter. Moreover, generating a RIPed version of a print job means that the RIPed version of the print job does not exist already, such that I am *creating* the RIPed version of the print job. By comparison, configuring a RIPing parameter implies that the RIPing parameter already exists (i.e., I am not *creating* the parameter); rather, I am providing this parameter with a specific meaning. For example, as noted above, an example parameter is the ability to RIP a particular PDL type, which can take on the value "yes" or "no." As another example, a type of parameter is whether to use print job values (for other parameters) or default values (for these parameters), which can take on the value "use the values specified in the print job," or the value "use the defaults values." Configuring a parameter, in other words, is not the same as generating a RIPed version of a print job; insofar as the prior art suggests the latter, it does not suggest the former, to which the claimed invention is limited.

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In summary, then, the prior art in combination does not rise to the level of suggesting configuration of a parameter, in contradistinction to the claimed invention. Generation of a version of a print job, which the prior art in combination does suggest, is not the same as configuration of a parameter. First, a version of a print job is not a parameter. Second, generating is not the same as configuring. For all of these reasons discussed above, therefore, the invention is *prima facie* nonobvious and patentable over the cited prior art in combination.

Conclusion

Applicants have made a diligent effort to place the pending claims in condition for allowance, and request that they so be allowed. However, should there remain unresolved issues that require adverse action, it is respectfully requested that the Examiner telephone Mike Dryja, Applicants' Attorney, at 425-427-5094, so that such issues may be resolved as expeditiously as possible. For these reasons, and in view of the above amendments, this application is now considered to be in condition for allowance and such action is earnestly solicited.

Respectfully Submitted,

February 9, 2009
Date

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